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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,196	07/06/2000	Denise E. Smith	ATL99003	5114

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WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036

EXAMINER

BARNIE, REXFORD N

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 07/01/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/611,196

Applicant(s)
SMITH ET AL.

Examiner
REXFORD BARNIE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 24, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

RJ Barne
REXFORD BARNIE
PRIMARY EXAMINER

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291).

Regarding claim 1, Holstrom teaches a calling card with a card portion and a key tag portion with information on the card to direct a user to call a number and a PIN associated with the card (see figs. 1-2). According to the disclosure, the card can be made of paper, plastic and so forth with a scope comparable to a conventional credit card (see col. 2 lines 47-53). Holstrom fails to teach that the card is separable into a two piece portion by means of a perforation even though the claim simply calls for separation, but based on the figs.

Taskett teaches a repaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it

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possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations in order to be able to keep articles such as keys on the key tag section in order to avoid losing one's keys.

Regarding claim 3, the combination including Holstrom teaches a card with a key tag hole through which a key can be inserted in (see figs.).

Regarding claim 4, see the explanation as set forth regarding claim 1.

Regarding claim 6, the combination including Holstrom in (see figs.) Teaches an identification number and a telephone number on both portions of the cards in (see figs. 1-2) when turned on both sides.

Regarding claim 7, Holstrom teaches a calling card with a card portion and a key tag portion with information on the card to direct a user to call a number and a PIN associated with the card (see figs. 1-2). According to the disclosure, the card can be made of paper, plastic and so forth with a scope comparable to a conventional credit card (see col. 2 lines 47-53). The personal information would simply read on the card user identifier such as displayed by Holstrom on (see fig. 1). Holstrom fails to teach that the card is separable into a two piece portion by means of a perforation even though the claim simply calls for separation, but based on the figs.

Taskett teaches a prepaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations in order to be able to keep articles such as keys on the key tag section in order to avoid losing one's keys.

Regarding claims 8-11, The combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett.

Regarding claims 13-14, the combination teaches the claimed subject matter in (see figs. of Holstrom).

Regarding claim 16, see the explanation as set forth as set above in claims 1 and 7 in addition to the fact that obviously a plurality of cards would be manufactured using plurality of blank cards initially and a computer means with a software means would have to implement and encode the cards with information to be utilized by a user. The customized multipurpose card reads on the card as taught by Holstrom in conjunction with Taskett.

Regarding claims 17-19, The combination teaches the claimed subject matter.

Regarding claim 22, see the explanation as set forth regarding either claim 1 or 7 because customizing the card reads on the teaching as taught by the combination which could include a unique identifier or identifier associated and displayed on the card.

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Regarding claims 21 and 24, The combination including Holstrom teaches being able to add an identifier on both portions of a card.

Regarding claim 28, Holstrom teaches a card which would be manufactured to have the size (scope) of a conventional card similar to a credit card with two portions which can be separate from each other with one portion comprising of a key tag (see figs. and disclosure). Holstrom fails to teach being able to separate the card into two portions by means of perforations. Separating articles from each other by means of perforations is notoriously well known.

Taskett teaches a prepaid telephone card which could have the size of a conventional prepaid telephone card wherein the card can be separated into two portions by means of perforations (see fig. 3). Furthermore, the card has an account identifier associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett into that of Holstrom thus making it possible to separate the card into a section containing a key tag portion as shown in (fig. 3 of Holstrom) by means of perforations in order to be able to keep articles such as keys on the key tag section in order to avoid losing one's keys.

Regarding claim 29, The combination teaches use of perforation in (see Taskett) and the number of perforations would be a design choice.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291) and further in view of Small (US Pat# 5,513,117).

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Regarding claim 2, The combination fails to teach the possibility of being able to personalized the card to include personal information *as desired by the user of the card even though this limitation is not specifically directed to the claimed subject matter*. It's notoriously well known to have designs or advertisements by a card producer or telephone provider displayed on a calling card. Small teaches an apparatus for dispensing personalized gifts wherein a user can personalize information on a gift which according to Small could include prepaid telephone calling cards

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of the combination thus making it possible to provide advertisement information to card users and if the card is a gift, being able to personalize a card for the recipient.

4. Claims 7, 12, 15, 16, 20, 22, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom in view of Small (US Pat# 5,570,081).

Regarding claims 7 and 22, Holstrom teaches a customized card which includes personal information which reads on the "card identifier" wherein according to Holstrom, the card can be separated into two portion to include a key tag portion through which a key chain can be inserted in (see figs.). *The fact that the card is to be customized by the user or the party purchasing the card to include the "personal information" is not directed to the claimed subject matter but for the sake of argument*, Small teaches an apparatus wherein cards including prepaid telephone

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cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card which can be used for making a call as a gift to a recipient.

Regarding claim 12, see the explanation as set forth in the rejection of claim 7.

Regarding claim 15, Holstrom teaches a multi-purpose card including a main portion and a key tag portion separable from each other in (see figs.) but fails to teach the limitation being able to customized information on the card as specified by a user.

Small teaches an apparatus and system wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card, which can be used for making a call, as a gift to a recipient.

Regarding claim 16, see the explanation as set forth regarding claim 7 in addition to the fact that a computer process would initially encode blank cards with information on the card wherein the information could include the standard information comprising of a unique PIN, the

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telephone number to call for activation and any personalized message as desired by the user in conjunction with the other information.

Regarding claim 20, The combination teaches being able to customize a card to include information which could include personal expression.

Regarding claim 23, see the explanation as set forth regarding claim 22.

Regarding claim 25, Holstrom teaches a multi-purpose card with a main portion and a key tag portion in (see figs.) with personal information (card identifier) on both sides of the card portions but fails to teach receiving a request from a user or purchaser of the card to customize a personalized expression on the card.

Small teaches an apparatus and system wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card, which can be used for making a call, as a gift to a recipient.

Regarding claims 26-27, The combination including Holstrom teaches the claimed subject matter.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holstrom (US Pat# 5,570,081) in view of Taskett (US Pat# 5,684,291) and further in view of Marc-Williams et al. (US Pat# 6,385,860).

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Regarding claim 30, The combination fails to teach the claimed subject matter but MacWilliams teaches a label and method for applying in (see fig. 1) wherein a label can be placed on perforation to protect the perforated means in (see figs. 1, 5 and disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this teaching into that of the primary references as means of providing a label covering the two-piece perforated piece for protection purposes.

Response to Arguments

6. Applicant's arguments filed on 04/24/2003 have been fully considered but they are not persuasive. .

The applicant argued basically the following arguments in response to the office action.

(I) The applicant argued that the combination including Holstrom as set forth in the rejection of claim 1 fails to teach a two-piece detachable card with a size approximately that of a calling card.

The examiner disagrees because the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the calling card such as taught by Holstrom. Furthermore, according to Holstrom in (see col.2 lines 49-51) the card can have a scope similar to that of a standard credit card. Also, all calling cards do not have the same size.

(II) The applicant argued in (pages 4-5) that the combination as set forth in the rejection of the claimed subject matter fails to teach personal information on a calling card.

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See the explanation as set forth in the rejection regarding claim 7. The examiner disagrees because personal information is broad and thus can be read on a unique identifier such as a PIN on an article. The fact that the personal information can be a specific information or customized by a user/purchaser/manufacture to be a specific information is not directed to the claimed subject matter.

(III) The applicant in (page 6) argued that the combination as set forth in the rejection of the claimed subject matter fails to teach a multi-purpose calling card, multi-purpose prepaid telephone cards, gift cards as set forth in claims 8-11.

The examiner strongly disagrees because the combination as set forth regarding Holstrom teaches a multi-purpose calling card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious.

(IV) The applicant argued that the combination as set forth in the rejection of claim 13 fails to teach a personal information because an identifier used by the examiner as an equivalent to the personal information is incorrect.

The examiner disagrees and believes the explanation as set forth regarding the claimed subject matter is proper and permissible. Furthermore, see explanation (II) as set forth above.

(V) Issue regarding claims discussed on (page 7) have already been discussed in the explanations as set forth above.

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(VI) The applicant argued that the combination as set forth in the rejection of the claimed subject matter fails to teach the specific number of perforations claimed, therefore, failing to establish a prima facie case.

The examiner disagrees because the combination including Taskett does not put a restriction on the number of perforation and therefore, would have been a matter of design choice.

(VII) The applicant argued in (pages 8-11) that the combination including Small as set forth in the rejection of the claimed subject matter of claim 2 fails to render the claim obvious because placement of one or more of promotional information, personal expressions and photographs on a key portion of the card is not taught by the combination.

The examiner disagrees because in rejecting the claimed subject matter, the examiner tried to show that being able to customize a card to include any desired information including personal expressions like greetings and so forth is well known such as taught by Small. In response to the applicant's argument that the fact that card is to be customized by a user or purchaser is not directed to the claim but implying that the card could include personal expressions as one of the options which according to the applicant's disclosure could be a picture of family, messages such as congratulations and so forth could mean that a user or purchaser could place any desired personal information on the card as a gift such as taught by Small. Placing company logos or advertising information on a card is also notoriously well known.

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(VIII) The applicant argued in (page 12) that the motivation for the combination including Small is based on hindsight and lacks motivation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, Small teaches being able to customize cards including calling cards for gift purposes with any desired information.

(IX) The applicant argued in (page 13) that placing information including a personal expression as one of the option on a card including a key tag portion and a main portion would not be obvious.

The examiner disagrees because it would have been obvious to one of ordinary skill in the art that desired information can be placed anywhere on the card as desired by a user or purchaser wherein the personal expressions could including messages or greetings such as taught by Small. Note that the combination including Holstrom teaches personal information (Identifier) on both portions of the card as a possibility.

(X) The applicant argued that the combination including MacWilliams fails to render claim 30 obvious.

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The explanation as set forth in the rejection of the claimed subject matter is believed proper and permissible because placing a label over perforations is known as taught by Macwilliams.

In summary, the explanation in the rejection as set forth regarding the claimed subject matter is believed proper and permissible.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **REXFORD BARNIE** whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to (703) 872-9314** and labeled accordingly (Please label

"PROPOSED/INFORMAL" or "FORMAL").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

Rexford Barnie
Patent Examiner
RB 06/20/03.

RBarnie
**REXFORD BARNIE
PRIMARY EXAMINER**